

REMARKS/ARGUMENTS

In response to the Official Action mailed September 15, 2003 and in accordance with the provisions of 37 CFR §1.111, Applicants submit the following amendments and response to be made of record in the above-identified case.

The Examiner has rejected pending claims 1-24 and 27-28 as allegedly obvious over US Pat. No. 4,289,813 to Blomeyer, et al. in view of US Pat. No. 4,238,594 to Pampouchidis. Applicants respectfully traverse this rejection for the reasons set forth below.

For at least the arguments presented herein, the Examiner has failed to meet this burden to establish obviousness and therefore the obviousness rejections should be withdrawn. Specifically, Blomeyer does **not** teach or suggest the use of a branched non-volatile monoalcohol. More particularly, Blomeyer simply describes the use of alcohols **below** a molecular weight of 200 in urethane coatings. Blomeyer does not distinguish between monoools or polyhydric aliphatic alcohols, and it does not disclose or suggest using long chain, non-volatile branched alcohols. Moreover, the disclosure is limited the molecular weight of suitable alcohols to below 200, which inherently means that there is a **maximum of 13 carbons on the backbone**. Since the linear C12 and C13 alcohols are not liquid at room temperature, their use to reduce viscosity vs. lower molecular weight diols and alcohols is unlikely and thus the prior art if anything, would point away from the present invention.

The deficiencies in the citation of Blomeyer are not corrected by looking at Pampouchidis, which also does not disclose or suggest the use of a **branched** non-volatile monoalcohol. Rather it simply describes the use of the isocyanate functional intermediate based on the reaction product of the isocyanate with the blend of amine, alcohol or acid. This isocyanate intermediate is further reacted with the base resin. The laundry list of the suitable alcohols includes saturated and unsaturated alcohols of the various chain lengths starting from C 6. These alcohols however are part of the binder system and are not used as a stand alone coating ingredients.

In order to establish a *prima facie* case, the Examiner must satisfy three requirements, none of which are met in the present case. First, the prior art relied upon, coupled with the knowledge generally available in the art at the time of the

invention, must contain some suggestion or incentive that would have motivated the skilled artisan to **modify a reference** or to combine references. See *Karsten Mfg. Corp. v. Cleveland Gulf Co.*, 242 F.3d 1376, 1385, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001) ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention."); *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998) (a showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding"). *Northern Telecom v. Datapoint Corp.*, 908 F.2d 931, 934, 15 U.S.P.Q.2d 1321, 1323 (Fed. Cir. 1990) (**It is insufficient that the prior art disclosed the components of the patented device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor.**). The teachings or suggestions, as well as the second requirement, expectation of success, must come from the prior art, not applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991).

In the present case, there is no motivation to look to *Blomeyer '813* in combination with *Pampouchidis '594* with respect to the present invention.

Second, the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. In other words, a hindsight analysis is not allowed. See *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209, 18 U.S.P.Q.2d 1018, 1023 (Fed. Cir. 1991).

Lastly, the prior art reference or combination of references must teach or suggest all the limitations of the claims. See *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970) ("All words in a claim must be considered in judging the patentability of that claim against the prior art.").

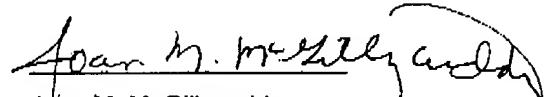
As set forth above the cited art does not teach or disclose or suggest the use of a branched non-volatile monoalcohol.

Conclusion

Based on the remarks made herein, the application and all papers filed in this case, it is believed that the case is in a condition for allowance, which allowance is respectfully requested.

It is believed that this response is being timely filed and that no fee is due. However, if an extension of time is required, Applicant herein petition for such extension of time such that this response is timely. Applicant herein authorizes that any and all charges due be charged to its Deposit Account No. 01-1350.

Respectfully submitted,


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